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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/950,902	10/15/97	HAGIWARA Y	S-2418

IM22/1105

SHERMAN & SHALLOWAY
413 NORTH WASHINGTON STREET
ALEXANDRIA VA 22314

EXAMINER	
SHERRER,C	
ART UNIT	PAPER NUMBER
1761	7

DATE MAILED: 11/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No. 08/950,902	Applicant(s) Hagiwara
	Examiner Curtis E. Sherrer	Group Art Unit 1761

☒ Responsive to communication(s) filed on *Aug 10, 1999* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-4 and 7-16* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-4 and 7-16* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 4, 10, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Again, Claim 2 is considered indefinite because it is unclear how the phrase "or a ground product thereof" embodies a limitation different from "grounds left after coffee extract is prepared." More specifically, the claim is not directed to non-ground roasted coffee beans but "grounds left after coffee extract is prepared from roasted coffee beans." The specification only has basis for using grounds, as seen on page 2, lines 9-12.

4. Again, Claim 4 is considered indefinite because there are no units associated with the claimed range. Applicant responded that said ratio is based on weight, e.g. grams of coffee grounds per grams of saccharide. This should be inserted into the claims as it is different than a volume per volume ratio.

5. Claim 10 is considered indefinite because the scope of the phrase "growth nutrients effective for the growth of said yeast." Specifically, it is not known what is "effective," as those

nutrients that are vital for the yeasts' growth change depending on their environment. It is noted that Applicants have stated that those in the art would know the scope of the phrase but supply no evidence to back up this argument.

6. Claim 15 is considered indefinite because the scope of the phrase "the residue remaining . . . in the manufacture of instant coffee" is unknown.

7. Claim 16 is considered indefinite because the scope of the phrases "substantially devoid of coffee extract" and "a coffee like aroma" is unknown.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Papazian (The New Complete Joy of Home Brewing, pp. 95-99) for the reasons set forth in the last Office Action.

10. Further, with regard to the use of a wine yeast, it is considered that the final product would inherently be the same. The main distinction between beer yeasts and wine yeasts is that wine

yeasts can tolerate high levels of ethanol. Therefore the product of Papazian would be indistinguishable from the claimed product as there is no limitation as to the ethanol level.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-4, 7-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi et al (U.S. Pat. No. 5,008,125).

13. Papazian teaches that cited above. He does not teach obtaining the coffee flavor and aromas from spent coffee grounds. While Papazian does not state what type of yeast was used to produce his alcoholic beverage, the use of wine yeast is notoriously well known in the production of high alcohol beverages.

14. Rizzi et al teach the use of defatted spent coffee grounds that are used to absorb bitter coffee flavors and burnt coffee aromas, whereby, after said flavors and aromas are absorbed by said spent grounds, the adsorbent is added to roasted ground coffee. (Abstract). The spent coffee is defatted with a solvent such as ethanol, (col. 6, lines 6-15). The spent coffee "is inexpensive, unadulterating, [and] tasteless" (col. 3, lines 6-9). The spent coffee can originate from an instant

coffee process (col. 3, line 67 to col. 4, line 2). It would have been obvious to those of ordinary skill in the art to produce alcoholic coffee drinks of Papazian using coffee produced by the coffee process of Rizzi et al because alcoholic beverage producers have traditionally added a wide variety of flavors, including coffee, to produce drinks with novel flavors and tastes.

15. In addition, Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi et al and in further view of Suzuki (U.S. Pat. No. 3,845,220).

17. Papazian in view of Rizzi et al teach that cited above but do not disclose the addition of a hydrolase. Suzuki teaches the addition of an enzyme, such as a protease, amylase, cellulase, hemicellulase and pectinase to modify the foaming properties of a coffee carbonated beverage. It would have been obvious to those of ordinary skill in the art to add a hydrolase as done by

Suzuki to the alcoholic beverages of Papazian in view of Rizzi et al because it is modifying a result effective variable that is beneficial to the foaming properties of the beverages.

Response to Arguments

18. Applicant's arguments filed 06/10/99 have been fully considered but they are not persuasive.

19. Applicant argues that the Claim 8 is not anticipated by the disclosure of Papazian because the claimed product is produced by a process not contemplated by said disclosure. Applicant states that "the extraction residue is totally different from the coffee obtained from freshly ground beans . . ." but goes no further in stating what those differences might be. It is considered that the ground extract coffee residue will contain the same chemicals as found in non-extracted coffee, but in lower concentrations. There is nothing on the record to indicate otherwise. Therefore, the broad product claim is considered anticipated because it will contain the same chemicals as found and extracted by Applicant's process. Applicant's attention is again directed to the holding in *In re Best*. Lastly, it is noted that the data found in the instant specification shows that the instant beverages have coffee color aroma and taste, as would a beverage made by the prior art method.

20. With regard to the obviousness rejection, Applicants arguments are moot in view of the new rejection set forth above.

Conclusion

21. No claim is allowed.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. Cale et al (USPN 5,008,708) teach that aroma can be recovered spent coffee grounds.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The **fax phone number** for this Group is (703)-305-3602.

27. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Curtis E. Sherrer

November 4, 1999